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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,996	02/14/2005	Gerard J Barry	05-002	5220
20306 7590 10/16/2008 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER				
ANDERSON, JOHN A				
ART UNIT		PAPER NUMBER		
3696				
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10/16/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/520,996

**Applicant(s)**

BARRY ET AL.

**Examiner**

JOHN A. ANDERSON

**Art Unit**

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. In the amendment filed June 11, 2008, the following has occurred: Claims 1 and 12 have been amended. Claims 1-24 are pending.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:  
A person shall be entitled to a patent unless –  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
3. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Weiss. A, (PGPub. No.: US 2002/0174031 A1).
4. As regards claims 1 and 12, Weiss discloses a method for effecting the performance of a payment card transaction for a first transaction amount in a first currency, between a first merchant and a first payment card holder, the method comprising the steps of:  
a) creating a first payment card transaction record between the first merchant

and a second cardholder for the first transaction amount, [0066]

b) Creating a second payment card transaction record between a second merchant and the first cardholder, wherein the second transaction record identifies a second transaction amount in a second currency which equates to the first transaction amount converted into the second currency, [0067]

c) submitting the first transaction record and the second transaction record for processing as payment card transactions. [0069]

5. As regards claims 2 and 13, Weiss discloses a method for effecting the performance of a payment card transaction according to claim 1, wherein the step of submitting the first transaction record and the second transaction record for processing comprises the step of submitting the first transaction record for processing as an unconverted payment transaction. [0055]
6. As regards claims 3 and 14, Weiss discloses a method for effecting the performance of a payment card transaction according to claim 1, wherein the step of submitting the first transaction record and the second transaction record for processing comprises the step of submitting the second transaction record for processing as a converted payment transaction. [0055]

7. As regards claims 4 and 15, Weiss discloses a method for effecting the performance of a payment card transaction according to claim 1, further comprising the steps of creating a third payment card transaction record between the second cardholder and the second merchant for an amount in the first currency, which is the negative equivalent of the first amount and submitting the third transaction for payment processing. [0016]
8. As regards claims 5 and 16, Weiss discloses a method for effecting the performance of a payment card transaction according to claim 4, wherein the third transaction is submitted as an unconverted payment card transaction. [0016]
9. As regards claims 6 and 17, Weiss discloses a method for effecting the performance of a payment card transaction according to claim 4, further comprising the initial step of determining whether a transaction is a dynamic currency convertible transaction prior to performing the steps of creating the one or more transaction records.[0014]
10. As regards claim 7, Weiss discloses a method for effecting the performance of a payment card transaction according to claim 4, further comprising the step of

posting the first and/or second and/or third transactions to the host computer system associated with an acquiring and/or multi-currency bank. [0068]

11. As regards claim 8, Weiss discloses a method according to claim 4, further comprising the step of creating a merchant additional revenue card transaction record between the second or a related cardholder and the first merchant, wherein the merchant additional revenue card transaction record identifies a transaction amount which equates to additional revenue to be settled to the first merchant in respect of performing at least one transaction using dynamic currency conversion. [0015]
12. As regards claims 9, 20 and 21, Weiss discloses a method according to claim 1, further comprising the step of creating a merchant additional revenue card transaction record between a cardholder account of the first merchant and the second merchant or an associated merchant thereof, the transaction record representing a refund which equates to additional revenue to be settled to the first merchant in respect of performing at least one transaction using dynamic currency conversion [0077]
13. As regards claims 10, 22 and 23, Weiss discloses a method according to claim 1, further comprising the step of creating a MBPMCSP card transaction record between the second or a related cardholder and a merchant associated with the

MBPMCSP, wherein the MBPMCSP transaction record identifies a transaction amount equating to the fees payable to the MBPMCSP for processing at least one dynamic currency transaction. [0077]

14. As regards claim 11, Weiss discloses a method according to claim 1, further comprising the step of creating a MBPMCSP card transaction record between a cardholder account of the MBPMCSP and the second (or an associated) merchant thereof, the transaction record representing a refund which equates to the fees payable to the MBPMCSP for processing at least one dynamic currency transaction. [0004]
15. As regards claim 18, Weiss discloses a system adapted to effect the performance of a payment card transaction according to claim 12, wherein the system comprises a payment card terminal. [0014]
16. As regards claim 19, Weiss discloses a system adapted to effect the performance of a payment card transaction according to claim 12, wherein the system comprises an intermediate or other host computer system adapted to receive payment transaction records from a payment card terminal or other device and route them for processing as either converted or unconverted transactions. [0019]

17. As regards claim 24, Weiss discloses a computer program having code embodied therein which when implemented on a computer effects the methods of claims 1. [0014]

### ***Response to Arguments***

18. Applicant's arguments filed June 11, 2008 have been fully considered but they are not persuasive. The amended claims 1 and 12 , , specifically the limitations "whereby processing said first record credits said first merchant and said processing second record debits said first cardholder " are anticipated by Weiss (0069).

Applicant submits that the step of 'create a first payment card transaction record between a first merchant a second cardholder' recited in amended claim 1 cannot be dissociated from the following recited step of 'creating a second payment card transaction record between a second merchant and the first cardholder.

Examiner cites Weiss paragraph [0070], "it is clear that various combinations of the components of the point-of-sale transaction system can be organized so as to provide interaction **between cardholders** 202, merchants 204, and multi-currency processors 218, and card issuers 224 in a variety of ways". It should be clear that more than one card holder partakes in a single card transaction.



***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JOHN A. ANDERSON** whose telephone number is (571)270-3327. The examiner can normally be reached on Monday through Friday 8:00 to 5:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John A Anderson/

Examiner, Art Unit 3696

John A Anderson

Examiner Art Unit 3696

/J. A. A./

Examiner, Art Unit 3696 10/09/2008

/Daniel S Felten/

Primary Examiner, Art Unit 3696

